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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,594	07/18/2003	Ralf Wichmann	07244-00135-US	4310
23416	7590	08/03/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,594

Applicant(s)

WICHMANN ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is in response to Paper received on 16 July 2004.

I. Applicant's election with traverse of Group I, material claims 1-4 in the reply filed on 16 July 2004 is acknowledged. The traversal is on the ground(s) that an additional search for an additional group of method claims is not burdensome. This is not found persuasive because an additional search is additionally burdensome, lacks focus on many and all issues, and dilutes patentability of many and all issues in the claims than those in one as elected.

The requirement is still deemed proper and is therefore made FINAL.

II. This application contains claims 5-8 are drawn to an invention nonelected with traverse in the reply filed on 16 July 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

III. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte

Phillip, 28 USPQ2d 1302. Please also see the related issue with respect no patentable sense as stated in *In re Hutchison*, 69 USPQ 138. The language “color developer”, “antioxidant”, “wetting agent” or the like is considered as the functional and characteristic property of a material as searched appeared.

B. *In re Schreiber*, 44 USPQ2d 1429 states that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in *Swinehart*... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” A statement or argument alone may have and be given a little to no value because it is not factual evidence as requested and required by law.

IV. Applicants’ prior art submissions have been considered to the extent of the English language being provided.

V. There have been found several dozens of references that would applied against the elected invention of Group I, material claims, in applicants’ prior art submissions and an initial search. Applicants will have a chance to see and answer to them all, if no sufficient amendment is made to the claims. A set of at least two references will be applied at a time when all of the references in the previous applied set is overcome.

VI. The language “concentrate” has and is given a little to no value since the requisite concentrations of chemical ingredients as broadly disclosed is within and below those in a ready-to-use. Please see those applicants’ prior art submission and those applied below and will be applied. Applicants should show or provide an evidence to the contrary in the next response to this Office action in order for it be considered timely. After this given period, no argument or evidence to this issue will be considered. The prosecution must be moved forth with other issues and applied prior art to be considered. It is forth seen that it may take up to several Office action to resolved all issues in this application. It is now notified and set forth the record.

VII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Twist (5,741,631).

Twist discloses, teaches, demonstrates and reduces to practices with the claimed material comprising 10 g/l of a color developing agent (CD3), 3.45 g/l of an antioxidant (HAS), and 0.6 g/l of a non-ionic surfactant (Tween 80). Please see the whole disclosure of the applied reference, especially at Example 1, Table 2, Developer Replenisher on col.7:22-39. Since Twist disclose, teaches, demonstrates and reduces to practice with the claimed material, claims 1, 3 and 4 are found to be anticipated by Twist.

VIII. Claims 1- 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Papai (5,891,609).

Papai discloses, teaches, demonstrates and reduces to practices with the claimed material comprising 4 g of potassium sulfite antioxidant, 70 g a color developing agent (CD3), 70 ml of 85% concentration of diethylhydroxylamine antioxidant, and 8 ml of a surfactant (Dowfax 3BO). Please see the whole disclosure of the applied reference, especially at Example 1 and about the same in Example 2. Since Twist disclose, teaches, demonstrates and reduces to practice with the claimed material, claims 1, 3 and 4 are found to be anticipated by Twist.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 10/622,594

Page 6

Art Unit: 1752

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
29 July 2004

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive style, with the first name "Hoa" and last name "Le" being more prominent than the middle name "Van".